UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,303	02/09/2001	Ronald L. Panter	P-3001.2ITEC	6780

7590 04/20/2006

Reising, Ethington, Barnes, Kisselle,
Learman & McCulloch, P.C.
P.O. Box 4390
Troy, MI 48099

EXAMINER
SILVERMAN, STANLEY S

ART UNIT	PAPER NUMBER
1754	

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09/780,303	02/09/2001	Panter et al.	P-3001.21TEC

EXAMINER	
Lish, Peter	
ART UNIT	**PAPER**
1754	20041221

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The reply brief, filed 10/14/04, has been noted by the examiner.

STANLEY S. SILVERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

Tom Dunn - conferee

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/19/2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. Upon further consideration, claim 8 has been allowed. A correct statement of the status of the claims is as follows:

Claims 1-8, 18, and 19 have been allowed.

Claims 28-38 have been withdrawn from consideration.

This appeal involves claims 9-17 and 20-27.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct. However, it is noted that Issue 1, drawn toward the patentability of claim 8, is no longer of concern, due to the allowance of claim 8.

(7) Grouping of Claims

The rejection of claims 9-17 and 20-27 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,733,484	UCHIDA et al.	03-1998
4,526,770	PEPPER et al.	07-1985
5,316,654	BERKEBILE et al.	05-1994
5,700,573	MCCULLOUGH	12-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9, 13-17, 20-24, and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepper et al. taken with Uchida et al. This rejection is set forth in a prior Office Action, mailed on 3/7/2003.

Claims 10-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepper et al. taken with Uchida et al. as applied to claim 9, and further in view of Berkebile et al. This rejection is set forth in a prior Office Action, mailed on 3/7/2003.

Claims 25-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepper et al. taken with Uchida et al. as applied to claim 9, and further in view of McCullough. This rejection is set forth in a prior Office Action, mailed on 3/7/2003.

(11) Response to Argument

Applicants argue that the examiner, in order to combine the teachings of two references, has shown neither an explicit teaching, nor an implicit suggestion or motivation, but rather has merely identified an advantage that the combination would realize. Applicants hold that the Federal Circuit requires, through *In re Oetiker* 24 USPQ2d 1443, that in order to show an implicit motivation, an examiner must show that one skilled in the art would know to use a prior art teaching to solve the same problem that the applicant seeks to solve through the invention in question. Applicant thereby determined that the advantage relied upon by the examiner does not represent an implicit motivation because Uchida et al. teaches carbonization (or calcination) in an oxidizing atmosphere only as an alternative way to solve the problem of how to carbonize carbon preforms, whereas the applicant's invention seeks to solve the problem of how to provide a continuous precursor fiber carbonizing process.

In response, the examiner intends to show that the combination of references is supported by an implicit motivating force. Examiner first points out that the applicants' reliance on In re Oetiker is improper. In re Oetiker discusses the distinction between analogous and nonanalogous art, and the motivation to combine two references that fall in different arts (specifically hose clamp art and garment art). In re Oetiker holds that the secondary reference to Lauro, although not within the appellant's specific field of endeavor, is nonetheless "analogous art" because it relates to a hooking problem, as does Oetiker's invention. In re Oetiker thus holds that in order to rely on a reference as a basis for rejection, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.

In the current issue, the prior art reference to Uchida et al., as well as the prior art reference to Pepper et al., deals with the process of altering carbon preform fibers into carbon fibers through the steps of stabilization and carbonization. The references are in the field of the applicant's endeavor and thereby meet the requirements of In re Oetiker as a basis for rejection. It is therefore not required that Uchida et al. intend to solve the problem of how to provide a continuous precursor fiber carbonizing process.

Furthermore, the examiner points to *Ex parte Levengood*, 28 USPQ2d 1300, which holds that the motivation for combining prior art references need not be explicitly found in references themselves, and the examiner may provide explanations based on logic and sound scientific reasoning that will support holding of obviousness. Uchida teaches the process of carbonization using an oxidizing atmosphere as an alternative to the process of carbonization using an inert gas. The motivation to select this alternative

lies in simple economic optimization. First, the use of an oxidizing atmosphere, such as air, avoids the higher costs of inert gases. Second, Uchida teaches that the process of carbonization under an oxidizing atmosphere is performed at a comparatively low temperature (of 400-600 °C as compared to the 500-2,500 °C preferred in a non-oxidizing atmosphere). Therefore, the use of an oxidizing atmosphere allows the process to be run at lower temperatures, requiring significantly less energy and costs to obtain.

Because performing carbonization under an oxidizing atmosphere achieves the same effect as carbonization under a non-oxidizing atmosphere and has obvious economic benefits, it would have been obvious to one of ordinary skill at the time of invention to replace the carbonization process of Pepper et al. with the alternative process taught by Uchida et al. No additional arguments are given for any of the claims that depend from claim 9, and they are therefore considered to stand or fall together with claim 9.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Peter J. Lish
August 6, 2004

Conferees
Stanley Silverman

Tom Dunn

Reising, Ethington, Barnes, Kisselle,
Learman & McCulloch, P.C.
P.O. Box 4390
Troy, MI 48099